REMARKS

In view of the foregoing amendments and the following remarks, reconsideration and allowance are requested.

Claims 46, 48 and 50 have been cancelled. Claims 1, 7, 12, 17, 21, 33, 45, 47 and 49 have been amended. Claims 1, 12, 21, 33, 45, 47 and 49 are the independent claims.

Response to the Objection to the Declaration

The Declaration stands objected to for reasons noted at page 2 of the office action. A new Declaration is enclosed to attend to this objection.

Response to the Objection to the Specification

The Specification was objected to for reasons noted at page 2 of the office action. The specification has been amended to attend to this objection. No new matter has been added.

Response to Objections under 35 USC §101

Claims 1-3, 5-13, 15-17, 19, 20, 45, 46, 49 and 50 were rejected under 35 USC §101 for reasons noted at pages 2-3 of the office action. This contention has been obviated by the amendment of the independent claims 1, 12, 21, 33, 45, 47 and 49. It is respectfully submitted that the claims, as presented, result in a useful and tangible result. Furthermore, it is respectfully noted that claim 1, as amended, recites the method carried out by a web server downloading an animated advertisement layer to a client machine on receiving a redirection from a host web page previously downloaded to the client computer. Therefore, the arguments stated on page 3, first paragraph of the office action are incorrect, i.e., it is wrong to suggest that the functional language of a layer adapted to contain animated content "adapted to run across a web page" does not clearly and positively set forth such running across a web page, since this feature is inherent in the web page layer itself and the actual running across the web page layer is not necessarily carried out by the web server that downloads the animated web layer to the client. Rather, the animated content is created by a graphics supplier – often referred to in the trade as a "publisher" – who then supplies the finished web page layer to an advertising agent who embeds the animated content in the web page layer for downloading to the client computer on receiving a

suitable redirection from a host web page previously downloaded thereto. Likewise, the arguments that downloading a layer "for displaying the animated content" does not actually include the positive displaying of the content, while true, is not applicable to claim 1, which relates to the web server and not to the client machine.

Response to Objections of Double Patenting

An objection of double patenting was made with regard to the claim pairs 45, 46; 47, 48; and 49, 50 for reasons stated on page 3, item 3, of the office action. Claims 46, 48 and 50 have been canceled to obviate this objection.

Response to Rejections under 35 USC §112

Claims 5, 15, 27 and 39 were rejected under 35 USC §112, first paragraph, for reasons noted at pages 4, item 5, of the office action. This rejection is respectfully traversed.

The Examiner's attention is drawn to page 8, lines 10-13, of the specification which states: "Thus, for example, whilst in the preferred embodiment, the animation is created using a vector graphics program, the invention equally well contemplates the use of video clips and other graphics formats." It is respectfully submitted that the artisan skilled in the graphic arts and familiar with web technology including HTML would fully understand from this description that the animated content can be a video clip and that no special skills are required to implement this beyond what is taught in the application. It is to be noted that in the case where the animated content is a video clip, this may be embedded in the web page layer so that triggering the video clip plays the clip at the client machine, thus causing the animated video clip to be rendered at the client machine and causing the animated object to travel across the screen.

Claims 7, 10, 17 and 19 were rejected under 35 U.S.C. 112, second paragraph, for reasons noted on page 4, item 7, of the office action. This rejection is respectfully traversed.

Claims 7 and 17 have been amended to provide the missing antecedent basis for the trigger signal.

Claims 10 and 19 relate to operations carried out by the web server and the appropriate hardware for doing so and not to the client machine. Thus, claims 10 and 19 both recite that the web server downloads the web page layer "during idle communications periods of the client

machine". Clearly, during this interval the web server is not idle, therefore it is submitted that there is no contradiction in saying that during this interval the client machine is idle since the act of receiving the data is not initiated by the client machine which remains passive during the act of the downloading the data. Moreover, independent claims 1 and 12, upon which claims 10 and 19 depend, respectively, have been amended by this response. The amendments to claims 1 and 12 have substituted the term "uploading" for the term "downloading" relating to actions carried out by the web server, which is the more correct term and hopefully clarifies this issue.

Response to the Rejection under 35 USC §102

For reasons stated on page 9, item 9 of the office action, claims 1, 4-9, 11, 12, 14-18 and 20-50 stand rejected under 35 U.S.C. 102(b) as being anticipated by Zapa Digital (WO 97/35280). This objection is respectfully traversed.

In general, it is respectfully suggested that the rejection does not fully appreciate the scope of the present invention, and consequently the following supplemental explanation will be provided with reference to the original disclosure. This explanation is completely supported by the original disclosure, and is provided for the patent office's better understanding. The Examiner is referred to the abstract (for example) clearly indicating that the invention relates to a method for downloading an animated advertisement. Examiner is also referred to Figs. 3 and 4 and their associated description beginning on page 5, line 22, which describes one embodiment that include the feature that the animated layer is downloaded during an idle time of the client computer.

Consider exemplary claim 1, as amended, which recites in relevant part:

"1.   (Amended) A method for presenting an animated advertisement on a web page, ...

(b) embedding the animated content in a web page layer that is separate from the host web page,

(c) receiving a redirection call from the client computer during an idle time of the client computer ...

(d) uploading said web page ... so that the animated advertisement appears superimposed on the host web page."

In contrast, Zapa Digital discloses a method and system suitable for use by an independent service provider who wishes to embed an animated content in his own host web page prior to uploading the thus modified host web page to a client computer. Zapa Digital does not teach nor suggest a method that allows a service provider to receive advertising content from a completely independent source and upload the advertising content to a client computer separately from the host web page for overlaying the host web page at the client computer. To the contrary, Zapa Digital discloses a method where the animation is internal to the host web page while in the present application the animation is external, i.e., "separate from the host web page" as now stated in the amended claims. Consequently, Zapa Digital fails to disclose or suggest a method of presenting an animated advertisement, as recited in claim 1, that includes embedding the animated content in a web page layer that is separate from the host web page, receiving a redirection call from the client computer during an idle time of the client computer, and uploading said web page ... so that the animated advertisement appears superimposed on the host web page.

Comparison to Prior Art Made of Record: Blossom, et al

Blossom et al. (US Patent No. 5,546,518, cited as prior art on page 7, item 7 of the office action) discloses a data processing apparatus including a graphics display device for displaying a display frame comprising a plurality of display frame pixels. A sprite management system composes the display frame from a plurality of graphic sprites. Each graphic sprite comprises a plurality of sprite pixels and corresponding sprite pixel values. Each sprite has a specified depth relative to the other sprites so as to permit a data processing device connected to access a display frame composition buffer to determine which features of a sprite will be visible and which will be hidden by another "uppermost" sprite. The data processing device is programmed to write pixel values of individual sprites to the display frame composition buffer. This writing begins with the pixel values of the sprite having the greatest depth and proceeds with the pixel values of the remaining sprites in order of decreasing sprite depth. However, contrary to Applicant's claimed invention, there is no suggestion in Blossom et al. to embed an animation object or sprite on a separate web layer that may be uploaded to a client independent

of the main or host web page with which the animation is associated while allowing both to be seen together in mutual association. Consequently, Blossom et al. fails to disclose or suggest a method of presenting an animated advertisement, as recited in Applicant's claim 1, that includes embedding the animated content in a web page layer that is separate from the host web page, receiving a redirection call from the client computer during an idle time of the client computer, and uploading said web page ... so that the animated advertisement appears superimposed on the host web page.

It would appear that the method disclosed by Zapa Digital may be based, in part, on a sprite mechanism taught by Blossom et al. In this regard, the Examiner's attention is referred to the specification section of Zapa Digital entitled: "TRANSPARENT 3D GRAPHIC OVERLAYS", which includes the following:

> "Although transparent image overlays, commonly known as 'sprites' are known in the art, they are generally limited to images produced by a 2D rendering and allow only 2D motion of the characters or objects in the images. A sense of depth is achieved only when 2D sprites are overlaid one upon another." [page 25, lines 27–30 of Zapa Digital]

None of the cited art teaches nor suggests downloading advertising content in a separate web page layer, as recited by Applicant's claim 1. Downloading advertising content in a separate web page layer allows the animation to be generated by an advertising publisher, for example, and then transferred to an advertising agency for embedding suitable links in the host web page so that selected animated advertisements can be downloaded for superimposition on the host web page in association with the host web page (but independent thereof). There is no suggestion in any of the cited prior art to download animated content that is independent of the host web page in this manner.

On page 5, item 9 of the office action, the Examiner contends that the triggering recited in claims 4, 7-9, 17, 18, 21-26, 29-31, 33-38 and 41-43 is taught by Zapa Digital. Applicant respectfully traverses this rejection.

It is acknowledged that Zapa Digital recognizes the need to trigger his "smart object" and that triggering *per se* is thus not itself new, however, it is averred that triggering was not hitherto necessary in the advertising industry and that therefore there is no motivation to provide triggering of an animated advertisement. In more detail, prior art methods of presenting advertisements do not require that the advert be triggered. This is because, as noted above, prior art advertisements are rendered in parallel with the rendering of the host page that calls them. Alternatively, they may be rendered interstitially, whereby they are displayed in an interval of time after a user has clicked on a hot-link displayed by a browser to retrieve a desired web page but before the browser has started rendering the web page. In this case, the advertisement may be downloaded after a host page is completely rendered but in such case the advertisement is not actually associated with the host page in that it is not displayed in association with the host page. In fact, the contrary is the case: the advertisement is typically displayed when the user exits from the host page *en route* to downloading a new link contained therein.

Response to 35 USC §103 Rejections

For reasons stated on page 6, item 11 of the office action, claims 2, 3, 10, 13, 19 and 5, 15, 27 and 39 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Zapa Digital. The Examiner argues that providers of web content also provide advertising themselves, or by a third party, therefore, the Examiner contends that it would have been obvious to have provided the advertising methods of Zapa Digital from either the content server or by a third party advertising server. The Applicant respectfully traverses this rejection.

Applicant does not dispute that providers of web content also provide advertising themselves, or by a third party. Indeed, it is precisely in recognition of this fact, and of the inherent difficulties of coordinating the advertising content with a host web page when they are procured independently, that the invention finds particular application. Thus, it is respectfully submitted that one of average skill in the art would do no more than embed a third party advertisement in their own host web page so as to display an animated advertisement content on the client computer. However, the applicant claimed invention does more: it obviates the need for the service provider of the host web page to embed the animated content in the host web page and allows it to be uploaded to the client computer *separately* from the host web. As a result, the

animated advertisement may be obtained from a source that is separate from the provider of the host web page where the animated advertising content is allowed to be associated with the host web page *without the need to modify the host web page* for accommodating the advertising content. This is the reason why the animated advertisement must be triggered since it is downloaded separately from the host web page and therefore is not controlled by the host web page.

The triggering feature described above is recited in independent claims 21, 33 and 47, relating to the client computer and associated software. Similarly, the triggering feature is recited in dependent claims 4 and 14 relating to the web server. However, this triggering feature is not recited in the other independent claims relating to the web server since the trigger signal need not be sent to the client computer by the web server. Alternative embodiments that may be used to provide the trigger signal are described in the application on page 6, lines 7-16.

As described above, the triggering and the separate procurement of the animated advertising content are related issues. With regard to these issues, we respectfully remind the Examiner that the USPTO Guidelines 706.02 set forth the criteria that must be adopted to support an objection of obviousness under 35 U.S.C. 103:

> "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or ***motivation***, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP Section 2143 - Section 2143.03 for decisions pertinent to each of these criteria.

> The initial burden is on the examiner to provide some suggestion of the ***desirability*** of doing what the inventor has done. *"To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references."* Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). See MPEP Section 2144 - Section 2144.09 for examples of reasoning supporting obviousness rejections. [emphasis added]

Applicant respectfully avers that the Examiner has failed to provide any motivation for triggering an advertisement after it has been uploaded to a client computer. As noted above, conventional advertising techniques require that a banner area be dedicated in the host web page and it is to this banner area that advertising content is subsequently downloaded. In such case, there is no need for triggering the advertising content since it is part of the host web page and not independent thereof.

Therefore, it is submitted that one skilled in the advertising and HTML arts, would likewise have associated any inherent triggering of the advertising content in the host web page. There would have no reason to provide external triggering either integral with the advertising content itself or provided in response to a client event. Indeed, triggering the advertising content independent of the host web page militates against conventional wisdom in the web advertising community where the supplier of the host web page is assumed to have total control over all objects embedded in the host web page.

On page 7, first full paragraph of the office action, with regard to claims 10, 13 and 19, the Examiner argues that Zapa Digital teaches overlaying the animation on top of a web page. As noted above there is no suggestion in Zapa Digital to provide the mechanism taught by the applicants claimed invention. Specifically, absent from Zapa Digital is any suggestion to embed the animation in a completely separate layer to the main web page so as to allow a host web page and animated content to be downloaded by the client independently and rendered simultaneously in mutual association so that the animated advertisement appears superimposed on the host web page.

None of the cited prior art discloses nor suggests a method of presenting an animated advertisement, as recited in claim 1, that includes embedding the animated content in a web page layer that is separate from the host web page, receiving a redirection call from the client computer during an idle time of the client computer, and uploading said web page ... so that the animated advertisement appears superimposed on the host web page.

Lastly, Applicant also asserts that the claimed invention addresses a long-felt commercial need in the advertising community. Prior to the technique taught by the Applicant, advertisements were displayed in a banner on a host web page. This not only limited the area

that could be dedicated to the display of advertising material, but the potential for animation was hampered.
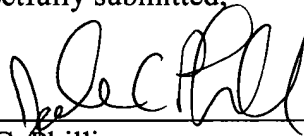
In conclusion, it is respectfully submitted that the claims, as presented, are directed to statutory subject matter and are patentably distinguished over the prior art. The art of record fails to disclose or suggest the features recited in the independent claims 1, 12, 21, 33, 45, 47 and 49, neither individually nor. Accordingly, claims 1, 12, 21, 33, 45, 47 and 49 are allowable for at least the reasons discussed above. The other pending claims depend either directly or indirectly from the independent claims. Accordingly, the dependent claims are allowable for the reasons that the independent claims are allowable and for reciting allowable subject matter in their own right. Independent consideration and allowance of the dependent claims are requested.

Accordingly, all of the pending claims are now in condition for allowance. A formal notice to that effect is respectfully requested. Attached is a marked-up version of the changes being made by the current amendment.

Applicant asks that all claims be allowed. Please apply any charges or credits to Deposit Account No. 06-1050.

Respectfully submitted,

Date: 11/8/02

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Version with markings to show changes made

<u>In the specification:</u>

Paragraph beginning at page 4, line 20 has been amended as follows:

Figs. 1a and 2a show a web page 10 written using HTML in known manner. Independently, an animated advertisement 11 is embedded within a separate web page layer 12 using known DHTML technology. The animation itself is likewise accomplished using off-the-shelf vector graphic tools and is not *per se* a feature of the invention. In a preferred embodiment reduced to practice, the animation was prepared using Flash, this being a proprietary vector graphics program produced and distributed by Macromedia Inc. [Details and virtual examples can be seen in their website http://www.flash.com/.] Flash is a registered trademark of Macromedia Inc.

<u>In the claims:</u>

Claims 46, 48 and 50 have been cancelled.

Claims 1, 7, 12, 17, 21, 33, 45, 47 and 49 have been amended as follows:

1.   **(Amended)**   A method for presenting an animated advertisement on a web page, comprising [the following steps, all carried out by a web server]:

    (a)   obtaining [a web page layer adapted to contain] an animated [advertisement] content having at least one object adapted to run across a <u>host</u> web page downloaded [to] <u>by</u> a client computer [connected to the] <u>from a</u> web server without obscuring or disabling portions of the web page lying outside a boundary of said objects at any given instant of time, [and]

    (b)   <u>embedding the animated content in a web page layer that is separate from the host web page,</u>

    (c)   <u>receiving a redirection call from the client computer during an idle time of the client computer requesting that the web page layer be uploaded to the client computer,</u>

    [(b)] (d)   [downloading] <u>uploading</u> said web page layer to the client computer responsive to said redirection call [for displaying] <u>displaying</u> [the] <u>an</u> animated advertisement content <u>in said</u>

web page layer in association with the <u>host</u> web page <u>so that the animated advertisement appears</u> <u>superimposed on the host web page in response to a trigger signal that is independent of the host</u> <u>web page</u>.

7.   **(Amended)**   The method according to Claim [1] <u>4</u>, wherein the trigger signal is independent of any autonomous activity performed by a user of the client computer.

12.   **(Amended)**   A web server for presenting an animated advertisement on a web page, the web server comprising:

a processor <u>for embedding the animated advertisement in a web page layer that is</u> <u>separate from the host web page and contains an animated advertisement content containing at least</u> <u>one object adapted to run across the web page without obscuring or disabling portions of the web</u> <u>page lying outside a boundary of said objects at any given instant of time,</u>

a memory coupled to the processor and storing [therein a] <u>the</u> web page layer <u>therein,</u> [adapted to contain an animated advertisement content containing at least one object adapted to run across the web page without obscuring or disabling portions of the web page lying outside a boundary of said objects at any given instant of time, and]

a communication mechanism coupled to the processor <u>and responsive to a</u> <u>redirection call from a client computer connected to the web server during an idle time of the client</u> <u>computer requesting that the web page layer be uploaded to the client computer</u> for successively [downloading] <u>and separately uploading</u> the <u>host</u> web page and the web page layer to [a] <u>the</u> client computer [connected to the web server].

17.   **(Amended)**   The web server according to Claim [12] <u>14</u>, wherein the communication mechanism is responsive to the processor for downloading to the client a mobile program for creating the trigger signal.

21.   **(Amended)**   A method for presenting an animated advertisement on a web page, <u>the method</u> comprising [the following steps all carried out by a client computer connected to a web server]:

(a)   downloading a <u>host</u> web page from the web server,

(b)   sending a redirection call to the web server during an idle time of the client computer requesting that there be uploaded to the client computer a web page layer separate from the host web page and containing the animated advertisement having at least one object adapted to run across the host web page without obscuring or disabling portions of the host web page lying outside a boundary of said objects at any given instant of time,

[(b)] (c)   superimposing the web page layer over said host web page [a web page layer containing the animated advertisement having at least one object adapted to run across the web page without obscuring or disabling portions of the web page lying outside a boundary of said objects at any given instant of time], and

[(c)] (d)   applying a trigger signal for starting the animated advertisement.

33.   (Amended)   A client machine for presenting an animated advertisement on a web page, the machine comprising:

a processor,

a memory coupled to the processor [and adapted to store therein a web page and a web page layer containing the animated advertisement containing at least one object adapted to run across the web page without obscuring or disabling portions of the web page lying outside a boundary of said objects at any given instant of time],

a communication mechanism coupled to the processor for downloading a host web page from a web server to said memory and for sending a redirection call to the web server during an idle time of the client computer requesting that there be uploaded to the client computer a web page layer separate from the host web page and containing the animated advertisement having at least one object adapted to run across the host web page without obscuring or disabling portions of the host web page lying outside a boundary of said object at any given instant of time,

a triggering unit coupled to the processor for applying a trigger signal for starting the animated advertisement, and

an overlay mechanism coupled to the triggering unit and responsive to the trigger signal for superimposing the web page layer over said host web page [a web page layer].

45. **(Amended)** A program storage device readable by machine, tangibly embodying a program of instructions executable by the machine to perform [method steps] <u>operations</u> for presenting an animated advertisement on a <u>host</u> web page, said [method steps] <u>operations</u> comprising:

(a) [downloading a] <u>uploading the host</u> web page to a client computer connected to the web server, [and]

(b) <u>receiving a redirection call from the client computer during an idle time of the client computer requesting that there be uploaded to the client computer a web page layer containing the animated advertisement containing at least one object adapted to run across the host web page without obscuring or disabling portions of the host web page lying outside a boundary of said object at any given instant of time,</u>

[(b)] <u>(c)</u> [downloading] <u>separately uploading the web page layer</u> to the client computer [a web page layer containing the animated advertisement containing at least one object adapted to run across the web page without obscuring or disabling portions of the web page lying outside a boundary of said objects at any given instant of time].

47. **(Amended)** A program storage device readable by machine, tangibly embodying a program of instructions executable by the machine to perform [method steps] <u>operations</u> for presenting an animated advertisement on a <u>host</u> web page, said [method steps] <u>operations</u> comprising:

(a) downloading [a] <u>the host</u> web page from a web server <u>to a client computer coupled to the web server,</u>

(b) <u>sending a redirection call to the web server during an idle time of the client computer requesting that there be uploaded to the client computer a web page layer separate from the host web page and containing the animated advertisement having at least one object adapted to run across the host web page without obscuring or disabling portions of the host web page lying outside a boundary of said objects at any given instant of time,</u>

[(b)] (c)   superimposing the web page layer over said host web page [a web page layer

containing the animated advertisement containing at least one object adapted to run

across the web page without obscuring or disabling portions of the web page lying

outside a boundary of said objects at any given instant of time], and

[(c)] (d)   applying a trigger signal for starting the animated advertisement.

49.   (Amended)   A program storage device readable by machine, tangibly embodying

a program of instructions executable by the machine to perform [method steps] operations for

presenting an animated advertisement on a host web page, said operations comprising [the

following steps]:

(a)   obtaining [a web page layer adapted to contain] an animated [advertisement] content

having at least one object adapted to run across a host web page downloaded [to] by

a client computer [connected to the] from a web server without obscuring or

disabling portions of the web page lying outside a boundary of said objects at any

given instant of time, [and]

(b)   embedding the animated content in a web page layer that is separate from the host

web page,

(c)   receiving a redirection call from the client computer during an idle time of the client

computer requesting that the web page layer be uploaded to the client computer,

[(b)] (d)   [downloading] uploading said web page layer to the client computer

responsive to said redirection call for displaying [the] an animated advertisement

content in said web page layer in association with the host web page so that the

animated advertisement appears superimposed on the host web page in response to a

trigger signal that is independent of the host web page.